

REMARKS/ARGUMENTS

This amendment responds to the April 8, 2003, Office Action in accordance with 37 C.F.R. § 1.116..

Claims 25 through 36 are pending in the application. Claims 25 and 32 are amended by this response.

A Request for Continued Examination and a Petition for Extension of Time for Two Months accompany this response. The official filing fees are paid by deposit account.

The applicants thank the Examiner for conducting an interview on September 3, 2003, with the applicants' attorney. Claims 25 and 32 are amended in accordance with comments exchanged during the interview. No new matter is added by these amendments.

1. Objection to Substitute Specification

The Examiner objects to the substitute specification filed February 24, 2003, stating the substitute specification has not been entered because it does not conform to 37 C.F.R. § 1.125(b). The applicants note that on page 3 at lines 10 through 11 of the February 24, 2003, Amendment/Submission, the applicants state that "the attached Substitute Specification (Appendix C) contains no new matter and meets the requirement of 37 C.F.R. § 1.125." The applicants again submit that the February 24, 2003, substitute specification includes no new matter. This objection should be withdrawn.

2. Priority Documents

The Examiner states that no copies of the priority applications filed in Germany on August 25, 1999, and November 9, 1999, have been received by the Office. The applicants will submit copies of these applications.

3. Information Disclosure Statement

The Examiner states that the information disclosure statement filed April 25, 2001, fails to comply with 37 C.F.R. § 1.98(a)(3) because it does not include a concise explanation of the relevance as it is presently understood by the individual designated in 37 C.F.R. § 1.56(c) most knowledgeable about the content of the information of each patent listed that is not in the English language. The applicants will submit a concise explanation.

4. Objections to the Drawings

The Examiner objects to drawings for various informalities. The applicants attach replacement sheets for Figures 2a1, 2a2, 2a4, and 2a3 with this response. The applicants note the amendment to the February 24, 2003, substitute specification, beginning on page 9 at line 24 and ending on page 10 at line 13. This objection should be withdrawn.

5. Objections to the Specification

The Examiner objects to the specification for various informalities. The applicants amend the February 24, 2003, substitute specification in accordance to the Examiner's suggestions. The applicants believe that the February 24, 2003, substitute specification overcomes the Examiner's objection under 37 C.F.R. §§ 1.71 and 1.75(d)(1). The February 24, 2003, substitute specification includes no new matter. This objection should be withdrawn.

6. Rejection to Claims 27, 29, 34, and 36 under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 27, 29, 34, and 36 under 35 U.S.C. § 112, first paragraph, stating that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The applicants traverse this rejection and request reconsideration. Support for claims 27, 29, 34, and 36 is found on page 15 at lines 7 through 25 of the original specification. This rejection should be withdrawn.

7. Rejection to Claims 26 and 33 under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 26 and 33 under 35 U.S.C. § 112, first paragraph, stating that the claims contain subject matter which was not described in the specification in such a way as to enable on skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants traverse this rejection and request reconsideration.

Specifically, the Examiner states that the specification fails to disclose the function recited in claims 26 and 33. The applicants submit that a person of ordinary skill in the art would not have to engage in undue experimentation to make and/or use the inventions of claims 26 and 33. The effect of the recited parameters can be observed over time and used to identify the position of the recess. This rejection should be withdrawn.

8. Rejection to Claims 25 through 36 under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 25 through 36 under 35 U.S.C. § 112, second paragraph, stating that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. The applicants traverse this rejection and request reconsideration.

Specifically, the Examiner states that the terms "high" and "highly" in the claims are relative terms which render the claims indefinite. The applicants submit that one of ordinary skill in the art is well versed on what regions of a roller bearing arrangement would be of "high" stress or are "highly" stressed in comparison to the other regions. The relative nature of high stress to regions of less stress can be observed over time. The use of these terms throughout the specification and within the claims is not indefinite and is understood by those skilled in the art. This rejection should be withdrawn.

The Examiner also states that it is not clear how a single reference could be provided in separate distinct "surface regions" as recited in the claims. The applicants refer the examiner to the February 24, 2003, substitute specification on page 9 at line 24 through page 10 at line 19 and to Figure 1a and 1b. This rejection should be withdrawn.

9. Rejection of Claims 25 through 30 and 32 through 36 under 35 U.S.C. § 102(b)

The Examiner rejects claims 25 through 30 and 32 through 36 under 35 U.S.C. § 102(b), stating that the claims are anticipated by U.S. Patent Number 4,512,679 to Petrzeka et al. The applicants traverse this rejection and request reconsideration.

The Examiner states in the September 3, 2003, Interview Summary that "[t]he recess 20 in the disclosed invention, Fig. 1a appears to differ structurally from the recesses 12 in Figs. 4 & 5 because the recess 20 is a singular, wide recess which is oriented asymmetrically on the surface 10. The prior art recesses 12 are multiple, narrow and oriented symmetrically about the surface 16. However, claim 25, as written, reads on both the disclosed invention and the prior art." The applicants amend claims 25 and 32 in accordance with comments exchanged during the September 3, 2003, interview. No new matter is added by these amendments.

The Examiner is required to support a rejection based upon anticipation with a citation that discloses each and every claims element. The Petrzelka et al. patent fails to disclose each and every element of the applicants' claims (as amended). This rejection should be withdrawn.

10. Rejection of Claim 31 under 35 U.S.C. § 103(a)


The Examiner rejects claim 31 under 35 U.S.C. § 103(a), stating that the claim is unpatentable over U.S. Patent Number 4,512,679 to Petrzelka et al. in view of U.S. Patent Number 1,700,991 to Wintercorn. The applicants traverse this rejection and request reconsideration.

The applicants submit that claim 25 is allowable over the Petrzelka et al. patent for the reasons discussed above. Claim 31 depends upon claim 25. The Wintercorn patent fails render obvious "a recess only in the region of high stress, [wherein] the recess being asymmetrical" as recited in amended claim 25. This rejection should be withdrawn.

11. Conclusion

The application is believed to be in condition for allowance. Favorable consideration is respectfully requested.

Respectfully submitted,

for  *Reg. No. 30,754*

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